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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/639,413 | 08/14/2000 | Mitsugu Ishihara | 450100-02646 | 1012 |
| 20999 | 7590 | 01/26/2005 | EXAMINER | |
| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | NATNAEL, PAULO S M | |
| | | | ART UNIT | PAPER NUMBER |

2614

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,413

Applicant(s)

ISHIHARA ET AL.

Examiner

Paulos M. Natnael

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification on page 12, lines 7-14, discloses, "The frame memory 27 temporarily stores the picture data, converted into digital data in the A/D converter 26, from one frame of the picture of the analog television broadcast demonstrated on the display monitor 3 to another. That is, data corresponding to a frame currently represented on the display monitor 3 is held in this frame memory 27. When the frame of the picture demonstrated on the display monitor 3 is switched to the next frame and data of the next frame is sent to the frame memory 27, the frame memory 27 is updated, so that the data of the next frame is held in the frame memory 27." The specification as originally filed does not disclose "a data frame memory capable of storing no more than one image at a time," as is now recited in claims 1 and 4. Thus,

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this is considered new matter. If applicant contends that it is not new matter, specific location in the specification, i.e., page and line number etc. should be pointed out.

3. Nevertheless, the examiner has considered the newly added limitation in the rejection as shown below, and the claims as claimed are still made obvious by the reference of Garland. Thus, this Office Action is made final.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garland, U.S. Pat. No. 6,366,359.

Considering claim 1, Garland discloses the following claimed subject matter, note;

a) the claimed a reception antenna for receiving television broadcast, is implied in the integrated digital television signal receiver (and video printer) of the type disclosed by Garland.

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c) the claimed a data frame memory capable of storing no more than one image at a time for transiently storing therein data from the received television broadcast representative of only one image, in which said one image is the same as that currently displayed by said picture display device, is met by buffer 212, fig.2, which stores a video image of at least one frame. (col.8, lines 6-8; see also col. 5, lines 26-29 and 50-55)

d) the claimed printing command inputting means for inputting a command for printing a desired image selected from the images displayed on said picture display device, is met by the print command button 110 on the remote controller 106, fig.1;

e) the claimed printing command outputting means for reading out the desired image from the data memory, is met by remote controller and Control means 210 which is coupled to synchronizing means 206 and allows a user to selectively view decompressed stored digital video signal 215 corresponding to images stored in buffer 212 and to print a hard copy of a selected image on printing means 216. Control means 210 may be any conventional control circuit comprising, for example, a remote control 106 as shown in FIG. 1, or in an alternate embodiment, a control panel 111. (col. 4, lines 33-40)

f) the claimed picture data synthesis means for synthesizing the received television broadcast with the desired image, thereby generating synthesized image data for

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display on the picture display device, is met by synchronizing means 206, fig.2; (see also the disclosure on col. 4, lines 20-32)

Except for;

b) the claimed display data outputting means for outputting the received television broadcast to a picture display device;

Regarding b), Garland discloses display means 208. Garland does not specifically disclose a separate display data outputting means for outputting picture data to the display means 208. However, the Examiner takes official notice here in that it is well known in the art that display systems comprise a display outputting means such a display controller or an encoder to encode the signal before it's transmitted to a monitor, and, therefore, it would have been obvious to the skilled in the art at the time the invention was made to modify the system of Garland by providing a display data outputting means such as an encoder for outputting the data as display data, in order for the image data to be displayed properly as desired by the user or viewer.

Considering claim 2, the claimed wherein said picture display device is connected over an internal bus to said display data outputting means is implied in a digital television system such as Garland's.

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Considering claim 3, wherein said printing device is connected over an internal bus to said printing command outputting means is met by line 215 connecting second decompressor 214 and printing means 216, Fig.2;

Considering claim 4, a picture data processing method comprising the steps of: receiving television broadcast; outputting the received television broadcast to a picture display device; transiently storing in a data frame memory; wherein said data frame memory is capable of storing no more than one image at a time data from the received television broadcast representative of only one image at a time, in which said one image is the same as that currently displayed by said picture display device, inputting a command for printing a desired image selected from the images displayed on said picture display device', reading out the desired image from the data frame memory to a printing device; synthesizing the received television broadcast with the desired image, thereby generating synthesized image data for display on the picture display device .

Claim 4 is a method claim of claim 1, and therefore, Claim 4 is rejected for the same reasons as claim 1.

Considering claim 5, the claimed wherein the step of synthesizing the received television broadcast with the desired image is terminated when said printing device prints the desired image, is implied here since the user activates the print process from

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a print preview mode, and the synthesizing step of the image would be terminated when the printing job is completed

Considering claim 6, wherein the step of synthesizing the received television broadcast with the desired image is terminated when a command for terminating the display the synthesized image data is inputted.

Regarding claim 6, see rejection of claim 5. (see also remote control print command button in Figs. 1 & 6)

Considering claim 7, wherein the step of synthesizing the received television broadcast with the desired image is terminated when a pre-set time has elapsed.

Regarding claim 7, although Garland does not specifically disclose termination of print image when a pre-set time has elapsed, the Examiner here takes Official Notice in that it is well known in the electronic/computer art to automatically terminate a process after a predetermined time has elapsed and allow the system to revert to a previous mode and wait for further command or instruction and, thus, it would have been obvious to the skilled in the art at the time the invention was made to modify the system of Garland by providing a termination process as in a software program, so that the system may not unnecessarily waste processing time and power.

Response to Arguments

6. Applicant's arguments filed August 11, 2004 have been fully considered but they are not persuasive. Response follows:

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Applicant's Arguments

Claim 1, as presented herein, recites in part as follows: a data frame memory capable of storing no more than one image at a time for transiently storing therein data from the received television broadcast representative of only one image at a time, in which said one image is the same as that currently displayed by said picture display device."

(Emphasis added). In explaining the above 103 rejection with regard to claim 1, the Examiner appears to assert that buffer 212 of Garland is the same as the frame memory of claim 1. It is respectfully submitted that buffer 212 of Garland is not the same as the present frame memory of claim 1. That is, unlike the frame memory of claim 1, the buffer 212 of Garland appears to be capable of storing more than one image. In support thereof, reference is made to lines 26-29 and 50-55 of column 5 of Garland...For reasons somewhat similar to those previously described with regard to claim 1, it is also believed that amended independent claim 4 is distinguishable from Garland.

Examiner's Response

Garland discloses an integrated digital television and video printer comprising a buffer memory 212 for temporarily storing the compressed signal before outputting it to the second decompressor 214 and beyond as desired. Frame buffers are notoriously well known in

the art for storing one image such as a frame of a video signal temporarily, momentarily or transiently. The buffer memory is capable of storing more than one image and, the buffer cannot be said to store one image. Garland

teaches that "when the print preview mode is activated, split window screen 104 appears on display area 102. Using remote control 106 or main control panel 111, the user can then view images of the stored broadcast and can select a particular frame of an image to be printed." (col. 3, lines 44-49) Furthermore, Garland teaches that a buffer memory, receiving the compressed digital video signal, for storing at least one static image from the compressed digital video signal including information corresponding to at least one frame, (col. 6, lines 52-55) and "storing at least one static image of the compressed digital video signal including information corresponding to at least one frame". (col. 8, lines 6-8) Also, a frame as is well known in the art comprises two fields of video data. The reference to "a plurality of images" could therefore, given a reasonably broad interpretation, mean at least two fields of video. Hence, the argument that Garland does not appear to disclose "a data memory capable of storing no more than one image at a time for transiently storing data from the received television broadcast representative of only one image, in which said one image is the same as that currently displayed by said picture display device", because the buffer 212 "stores a plurality of images" not only one image, is unpersuasive, because, as shown above, Garland clearly discloses storing at least one frame in the buffer memory 212, and a frame is comprised of two fields which can be interpreted as "a plurality of video images", as Garland teaches.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paulos M. Natnael whose telephone number is (703) 305-0019. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAULOS M. NATNAEL
PATENT EXAMINER

PMN

January 12, 2005